



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/518,459

12/22/2004

Mika Watanabe

MARU.001

5043

21254

7590

03/06/2008

MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA, VA 22182-3817

EXAMINER

PETERSON, KENNETH E

ART UNIT

PAPER NUMBER

3724

MAIL DATE

DELIVERY MODE

03/06/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1 Applicant argues that Groswith's sheet-to-be-punched is inserted from a different direction than his. However, the insertion of the sheet is a method step that cannot be given full weight in an apparatus claim. In an apparatus claim, such a recitation is only given weight inasmuch as the prior art must be *capable* of receiving the sheet from that direction. In this case, Groswith is definitely capable of receiving the sheet from the recited direction, even though there is no disclosure to do so.

In order to distinguish over the likes of Groswith, Applicant must add *structure* to the independent claim, as opposed to the *intended use recitations* that he is relying on.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth E. Peterson whose telephone number is 571-272-4512. The examiner can normally be reached on Mon-Thur, 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/Kenneth E Peterson/
Primary Examiner, Art Unit 3724